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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,049	01/18/2001	Gavin Brebner	B-4084 618514-1	7680

7590 12/01/2004

HEWLETT-PACKARD COMPANY  
P. O. BOX 272400  
3404 E. Harmony Road  
Intellectual Property Administration  
Fort Collins, CO 80527-2400

EXAMINER

TIV, BACKHEAN

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/765,049

**Applicant(s)**

BREBNER, GAVIN

**Examiner**

Backhean Tiv

**Art Unit**

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Detailed Action***

This action is a response to the amendment filed on 8/12/04.

Claims 1-17 are pending in this application.

***Information Disclosure Statement***

Has been considered in the previous Office Action, mailed 3/9/04.

***Priority***

Has been acknowledged in the previous Office Action, mailed 3/9/04.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16, 17 is dependant on claim 1. Claims 16, 17 recites an apparatus, while claim 1 recites a method.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/16003 issued to Newman in view of US Patent 5,860,071 issued to Ball et al (Ball).

As per independent claim 1, Newman teaches process for personalized access to information available on the Internet network, characterized in that it involves the steps of:

creating at least one profile file comprising private data owned by the user, and/or data regarding the technical specifications of the user's computer (page 2, lines 28-29);

in order to receive an offer file comprising matching rules for matching services accessible via the internet to said at least one profile (page 10, lines 7-14);

applying the matching rules in the offer file to the profile file in order to select one or more services from the offer file (page 5, lines 28-31 and page 6, lines 1-3);

generating a HTML page in the user's computer describing said selected services (page 5, lines 1-30, page 6, lines 3-9);

pushing said HTML page into a web browser in the user's computer for permitting direct access to the services selected (page 5, lines 1-30, page 6, lines 13-17).

However Newman does not teach repeatedly polling a service provider.

Ball teaches repeatedly polling a service provider(col.5,lines 64-67 and col.6,lines1-23)

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Newman to add repeatedly polling a service provider as taught by Ball in order to keep track of changes in a document repository in an efficient manner (Ball, col.2,lines 14-15).

One ordinary skilled in the art would have been motivated to combine Newman and Ball to provide a process for the user to be informed of changes on webpages(Ball, col.2, lines 14-55).

As per claim 2, process according to claim 1 comprising creating and updating a local file comprising the selected services(Ball, Fig.6,col.6,29-32). Motivation to combine set forth in claim 1.

As per claim 3, process according to claim 2 characterized in that the polling is executed after a predetermined period(Ball, col.5,lines 64-67 and col.6,lines 1-23), and when the user requests the establishment of an Internet connection(Newman, page 5, it is inherent that there is an establishment of an Internet connection because the user is receive web pages).Motivation to combine set forth in claim 1.

As per claim 5, process according to claim 1 characterized in that said at least one profile file comprises private data regarding the user and technical data relating to the user's computer(Newman, page10, lines 11-14,31 and page 11, lines 1-3; it is inherent that there is technical data relating to the user's computer because advertisements are being sent to inform the users for upgrades).

As per claim 7, process according to claim 1 characterized in that it is used for achieving an electronic business application(Newman, page 1, lines 30-31).

As per claim 8, computer program product comprising computer program code stored on a computer readable storage medium for, when executed on a computer, performing all the steps of claim 1(Newman, page 2-28 ).

Claim 9 is of the same scope as claim 1. Claim 1 recites a method while claim 9 recites an apparatus, therefore is rejected based on the same rationale (see claim 1 rejection).

Claim 10 is of the same scope as claim 2. Claim 2 recites a method while claim 10 recites an apparatus, therefore is rejected based on the same rationale (see claim 2 rejection).

Claim 11 is of the same scope as claim 3. Claim 3 recites a method while claim 11 recites an apparatus, therefore is rejected based on the same rationale (see claim 3 rejection).

As per claim 12, process according to claim 1 wherein the HTML page is generated at the user's computer in response to the occurrence of predetermined conditions(Newman, page 6, lines14-17).

As per claim 13, apparatus according to claim 9, wherein the means for generating the HTML page resides on the user's computer and wherein the HTML page is generated in response to the occurrence of predetermined conditions(Newman, page 6, lines 14-17).

Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/16003 issued to Newman in view of US Patent 5,860,071 issued to Ball et al(Ball) in further view of US Patent 5,710,884 issued to Dedrick.

Newman in view of Ball teaches all the limitations of claim 1, however does not teach as per claim 4, process according to claim 1 characterized in that said profile file is encrypted into said local user machine.

Dedrick teaches characterized in that said profile file is encrypted into said local user machine(col.6,lines 22-27).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Newman in view of Ball to add characterized in that said profile file is encrypted into said local user machine as taught by Dedrick in order to protect the user profile from anyone other than the individual who is associated with the information (Dedrick, col.6,lines 24-25).

One ordinary skilled in the art would have been motivated to combine Newman, Ball and Dedrick to provide a process to protect information(Dedrick, col.6, lines 24-25).

Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/16003 issued to Newman in view of US Patent 5,860,071 issued to Ball et al(Ball) in further view of US Patent 6,035,339 issued to Agraharam et al. (Agraharam).

Newman in view of Ball teaches all the limitations of claim 1 however does not teach as per claim 6, process according to claim 1 characterized in that said at least

one profile comprises technical data that is automatically collected by means of an analysis software program.

Agraharam teaches characterized in that said at least one profile comprises technical data that is automatically collected by means of an analysis software program(col.4,lines 14-17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the process of Newman in view of Ball to add characterized in that said at least one profile comprises technical data that is automatically collected by means of an analysis software program as taught by Agraharam in order to more conveniently determine the user terminal capabilities(Agraharam, col.1,lines31-35).

One ordinary skilled in the art would have been motivated to combine Newman, Ball, Agraharam to provide a process which automatically determines end-user information(Agraharam, col.1, lines 38-40).

Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/16003 issued to Newman in view of US Patent 5,860,071 issued to Ball et al(Ball) in further view of US Patent 6,330,569 issued to Baisley et al.(Baisley).

Newman in view of Ball teaches all the limitations of claim 1, however does not teach as per claim 14, process according to claim 1 wherein the at least one profile file is a XML file stored on the user's computer, and as per claim 15, process according to



claim 14 wherein the offer file is an XML file repeatedly downloaded from the service provider and stored on the user's computer.

Baisley teaches at least one profile file is a XML file stored on the user's computer and wherein the offer file is an XML file repeatedly downloaded from the service provider and stored on the user's computer(Abstract).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the process as taught by Newman in view of Ball to add at least one profile file is a XML file stored on the user's computer and wherein the offer file is an XML file repeatedly downloaded from the service provider and stored on the user's computer as taught by Baisley in order to provide updates(Baisley, col.2, line54-67).

One ordinary skilled in the art at the time of the invention would have been motivated to combine Newman, Ball, and Baisley in order to provide a process where the user can update software on their computers(Baisley, col.2, lines 54-67).

Claim 16 is rejected for the same reason as claim 14(see above).

Claim 17 is rejected for the same reason as claim 15(see above).

### ***Response to Arguments***

The applicant has amended the claims to overcome the claim objections and the 112 2<sup>nd</sup> paragraph rejection, therefore the examiner withdraws the claim objections and 112 2<sup>nd</sup> paragraph rejection in the previous Office Action mailed 3/9/04. The new claims added however, raises 112 2<sup>nd</sup> paragraph issues.

The applicant has amended independent claim 1 and 9 to try to overcome the previous 103(a) rejection of Newman in view of Ball. The applicant amended the claims to say "generating a HTML page in the user's computer" and "pushing said HTML page into a web browser in the user's computer". These limitations however, does not overcome Newman in view of Ball. Newman, page 5, teaches both of these limitations. When a user accesses the web page, this web page is generated on the user's computer and is pushed from the server to the user's computer.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571)272-3941. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2151

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Backhean Tiv  
2151  
11/21/04



ZARNI MAUNG  
PRIMARY EXAMINER